

Application No. 08/951,832
Amendment dated November 8, 2006
Reply to Office Action of June 8, 2006

REMARKS/ARGUMENTS

Claims 3-8, 13, 16-25, and 27-30 are pending in the application. Claims 13 and 16-21 have been withdrawn from consideration. Claims 24-25 previously depended upon a withdrawn claim and are amended to depend upon a pending claim. Claims 27-30 are new claims.

Claims 3-4, 8, and 22-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,437,651 (Todd) in view of U.S. Patent No. 4,631,061 (Martin). Claims 5-7 are rejected under § 103(a) as unpatentable over Todd in view of Martin and U.S. Patent No. 4,886,502 (Poirier). The applicants traverse each of these rejections and respectfully request reconsideration in view of the following remarks.

The Prior Art Does Not Teach or Suggest All of the Claimed Limitations.

Independent claim 8 is allowable because none of the cited references teaches or suggests, among other things, "an elastomeric film dressing for securing said porous pad within said sealable space." The office action alleges that pad backing 16 of Todd is an elastomeric film dressing that serves to secure the foam pad 12 in a sealable space, but this is incorrect. Claim 8 recites that "said sealable space" is "defined in part by a wound surface." Todd, however, is directed to methods and apparatus for collecting blood and other fluids lost from a patient during surgery. Todd mentions nothing of a sealable space defined in part by a wound surface, much less that pad backing 16 secures foam pad 12 in such a sealable space. To the contrary, foam pad 12 is placed "*against* the area from which the fluid is to be collected" (col. 7, ll. 31-33) (emphasis added), and Figure 12 illustrates that foam pad 12 is applied over an organ without any seal. Pad backing 16 is intended to provide flexible support for foam pad 12, so that foam pad 12 may retain various shapes to accommodate varying shapes of organs and tissue. Pad backing 16 is not capable of securing foam pad 12 in anything, and the office action points to nothing in Todd that

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suggests otherwise. Without more, the office action has failed to establish that Todd teaches or suggests this aspect of the applicants' claimed invention.

Todd also fails to teach or suggest, among other things, that the dressing "is coated at least in the peripheral areas with a pressure-sensitive adhesive," as the office action suggests. Rather, Todd states only that pad backing 16 is "attached" to foam pad 12. Without more, the office action has failed to establish that 'the 651 patent teaches or suggests this aspect of the applicants' claimed invention.

Accordingly, the applicants respectfully request that the examiner withdraw the rejection of claim 8 and its dependents under 35 U.S.C. § 103(a).

The Office Action Does Not Provide Substantial Evidence of the Alleged Motivation to Combine the Teachings of the References.

Moreover, the applicants respectfully remind the examiner that "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The examiner may not evaluate the applicants' claims "part by part," using the claims as a "roadmap to find its prior art components." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). Most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "Thus, every element of a claimed invention may often be found in the prior art" and the examiner must consider the claimed invention as a whole. *Id.* at 1369-70; *accord* MPEP § 2141.02. There must be some motivation, suggestion or teaching of the desirability of making the specific combination to establish obviousness based on a combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; *accord* MPEP § 2143.01. The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one of ordinary skill in the art. *Beckson*

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Marine, 292 F.3d at 728. It is the duty of the examiner to identify the source of the motivation, and to explain why the combination of the teachings is proper. *In re Rouffet*, 149 F.3d 1350, 1356-57 (Fed. Cir. 1998); *In re Fitch*, 972 F.2d 1260, 1266 ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification"). Hindsight reconstruction is impermissible. *Id.*

An alleged suggestion or motivation to modify the teaching of the prior art must be supported by particular findings and substantial evidence. *Kotzab*, 217 F.3d at 1370 & 1371. Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Kotzab*, 217 F.3d at 1369. Broad conclusory statements of suggestion or motivation standing alone are not "evidence." *Id.* at 1370.

The references cited in the office action not only fail to teach or suggest all of the claimed limitations, as discussed above, but it merely provides broad conclusory statements regarding the alleged motivation to combine the references in a manner that would render obvious independent claim 8 and its dependents. With respect to claim 8, for example, the office action states only that it would be obvious to modify Todd because Martin "teaches that the filter in this position has the dual function of preventing urine odor from escaping said urine tank and reducing pump noise." The office action does not provide substantial evidence or particular findings to explain how preventing odor from escaping or reducing pump noise suggests incorporating a bacterial filter into an apparatus for promoting wound healing, nor does it identify the *source* for the alleged motivations. *Rouffet*, 149 F.3d at 1356-57; *Fitch*, 972 F.2d at 1266.

Accordingly, the office action fails to meet the burden of a prima facie case of obviousness under § 103, and the applicants respectfully request that the examiner withdraw the rejection of claim 8 and its dependents under 35 U.S.C. § 103(a).

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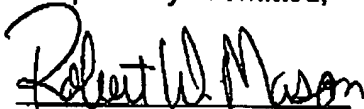
CONCLUSION

The applicants have distinctly and specifically pointed out at least one error in the examiner's action, and submit that pending claims 3-8, and 22-30 are in condition for allowance. Accordingly, the applicants respectfully request that the examiner issue a Notice of Allowance for these claims. The examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

If a Petition for Extension of Time under 37 C.F.R. 1.136(a) or an additional Petition for Extension of Time under 37 C.F.R. 1.136(a) is required, the petition is herewith made and the Commissioner is authorized to charge the required fee to deposit account number 500326.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment made with this Office Action, to Deposit Account Number 500326.

Respectfully submitted,


For Applicant

Robert W. Mason, Reg. No.: 42,848
Intellectual Property Counsel
Kinetic Concepts, Inc.
Legal Department – Intellectual Property
8023 Vantage Drive
San Antonio, Texas 78230
Telephone: 210.255.6271
Facsimile: 210.255.6969
E-mail: masonrw@kci1.com

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